

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/526,184

Applicant(s)

MORITA ET AL.

Examiner

Nissa M. Westerberg

Art Unit

1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Nissa M Westerberg/
Examiner, Art Unit 1618

/Jake M. Vu/
Primary Examiner, Art Unit 1618

Continuation of 11. does NOT place the application in condition for allowance because: The rejections under 35 USC 103(a) of claims 1, 3 - 5, 8 - 10 and 12 over Dalle et al. (US 6,013,682; '682 patent) in view of Lochhead et al. (1993) or Sang et al. (US 6,143,310) in view of Dalle et al. (US 6,013,682) are MAINTAINED for the reasons of record set forth in the Office Action mailed April 24, 2009 and those set forth below.

Applicant traverses this rejection on the grounds that contrary to the assertions of the examiner, emulsions are formed in the '682 patent, the order of addition of ingredients are the same in the '682 patent and in one of the comparative examples 1 - 3 of the instant applications, similar ratios of components are utilized and this ratio is irrelevant as this is not a claimed feature and mixtures of ethers are not included in one of the examples of the instant application.

These arguments are not found persuasive. The comparisons must be made between the compositions of the instant application and the cited prior art. Thus, similar but not identical ratios of ingredients and the same order of addition in one but not all three examples mean that a proper comparison being made is not with the closest prior art. The emulsions prepared in '682 include laureth-3 and laureth-23, ingredients which are not present in the comparative examples 1 - 3 of the instant specification. While the ratio of ingredients in the comparative examples of the instant application and '682 may be similar, that is not sufficient. The ratio of these components determines the structure of the polymer that is obtained. From the information provided, the Examiner cannot determine if the three examples of component (A) given are sufficient to establish a trend that encompasses all linear organosilicon polymers with a main chain composed of diorganosiloxane units and alkylene units. As the claims are silent to this ratio, the claims do, as pointed out by Applicant, encompass all such polymers. While Applicant need not present data for all compositions encompassed by the claims, there is insufficient evidence to show a trend that would provide support for the entire claimed range.

The compositions of the instant claims contain two components, component (A) which has been discussed above, but also component (B), an oil that is liquid at room temperature and does not contain hydrosilation-reactive groups. The examples discussed in regards to the unexpected results on make use of one such oil. From one data point, it is difficult to establish a trend that supports unexpected results for all such oils that meet this limitation.

Therefore, the examples discussed are not a comparison with the closest prior art and are not sufficient to rebut the prima facie case of obviousness for the full breadth of the claims. Therefore, the rejections are maintained..